

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: FITZGIBBON, Russell Patrick

SERIAL NO.: 10/705,681

ART UNIT: 3722

FILED: November 12, 2003

EXAMINER: Cadugan, E. E.

TITLE: TOOL HOLDER ARRANGEMENT

AMENDMENT "B"

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action of July 15, 2005, a response being due by October 15, 2005, please amend the application as provided herein and consider the following remarks:

REMARKS ON AMENDMENT B

Upon entry of the present response, Claims 1-2, 5-6, 10-14 and 17-25 remain pending. Reconsideration of the rejections, in light of the foregoing amendments and present remarks, is respectfully requested. The present amendments has been entered to more clearly distinguish the present invention from the prior art.

Claims 1-2, 4-6, 10-14 and 17-18 have been elected. Claims 3, 7-9 and 15-16 have been canceled as non-elected species. Claims 19-25 are newly added dependent claims drawn to independent Claim 17 in order to correspond to the dependent claims drawn to independent Claim 1. No claims have been added above the amount originally paid for. The Examiner also made several formality objections to the claims (Claim 18) and the drawings.

In this Official Action, Claims 1-2, 4-6, 10-14 and 17-18 were rejected for failing to particularly point out and distinctly claim the subject matter of the invention. Claims 1-2, 4-6, 10-11, 13-14 and 17-18 were rejected as being anticipated by U.S. Patent No. 5,413,573 issued to Koivukangas. Claim 12 was specifically rejected as being made obvious by the same U.S. Patent No. 5,413,573 issued to Koivukangas.

As an overview to the present reply, Applicant has amended Claims 1-2, 4-6, 10-14 and 17-18, according to the suggestions of the proposed Examiner's Amendment of June 2, 2005. Claim 4 has been canceled. Claims 19-25 have been added to account for the amendments made in a corresponding European patent application.

Applicant previously could not agree to the proposed Examiner's Amendment of June 2, 2005 and respectfully disagrees with the rejections based upon the Koivukangas patent. However, Applicant is desirous of obtaining patent protection at the earliest possible date and has presented the following amendments to Claims 1-2, 4-6, 10-14 and 17-18. These changes are identical to the Examiner's Amendment, wherein the sensor arrangement subject matter of dependent Claim 4 has been incorporated into independent Claims 1 and 17. As such, Claim 4 has been canceled.

Applicant has also presented Claims 19-25, which are analogous dependent claims, corresponding to Claims 2, 5-6, 10, and 12-14 related to independent Claim 17. These claims are presented because of amendments made in a corresponding European patent application. The Applicant could not agree earlier to the proposed Examiner's Amendment of June 2, 2005 because the Applicant decided to wait for allowance of pending amendments in the corresponding European patent application. Claim 17 and its dependent Claims 19-25 disclose the subject matter of a tool holder to sense at least two features and the previously disclosed dependencies for sensing one

feature as applied to sensing at least two features. In compliance with U.S. formalities, these dependent claims are the expanded versions of multiple dependent claims, which are allowable for European patents. No new subject matter has been added by these dependent claims because these dependent claims were previously applied to Claim 1 for sensing one feature. They are now being applied to a tool holder for sensing at least two features.

Furthermore, no excess claim fees are due because seven claims have been canceled and seven claims have been added. The total number of claims still does not exceed twenty.

Based upon the suggested Examiner's Amendment, Applicant has proposed a set of claims incorporating the changes approved by the Examiner and the concerns of the European Applicant.

Claim 18 has been amended according to the Examiner's suggestion. The replacement drawing sheet is also presented according to the suggestion of the Examiner.

Based upon the foregoing analysis, Applicant contends that independent Claims 1 and 17 are now in proper condition for allowance. Additionally, those claims which are dependent upon these independent claims should also be in condition for allowance. Reconsideration of the rejections is requested and allowance of the claims at an early date is earnestly solicited. Since no additional claims have been added above those originally paid for, no additional fee is required.

Respectfully submitted,

Date _____

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Amendment B: DRAWING AMENDMENTS

Please substitute the enclosed one (1) pages of drawings (Figures 1-2) in place of the previously submitted drawings. The correction is the substitution of "18" for "8" in Figure 1 on the left side of Figure 1. The page is labeled as "REPLACEMENT SHEET" in the header.